

REMARKS

The present communication is responsive to the Final Office Action mailed June 23, 2003.

By way of the present amendment applicants have cancelled claims 10 and 11. Thus claims 1 - 9 and 12 - 18 remaining pending in the application.

Claim 6 has been amended to now recite "transmitting the modified information about the product to the first entity."

In the Final Action, the Examiner indicated that applicants' arguments filed in the amendment of June 10, 2003 "have been fully considered but they are not responsive." On the other hand, the Examiner also indicated that the amendment of June 10, 2003 was "not fully responsive to the prior Office Action because applicant failed to correct the specification." [Emphasis Added.] In addition the Examiner indicated that "this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a)."

37 CFR §1.135(c) states that "[w]hen a reply by the applicant is a *bona fide* attempt to advance the application to final action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under §1.134 to supply the omission." In instructing Examiners pursuant to 37 CFR §1.135(c), MPEP §714.03 states "[w]here an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat

every rejection, objection or requirement), the Examiner may simply act on the Amendment and issue a new (non-final or final) Office action." [Emphasis Added.] On the other hand, MPEP §703.14 states "[w]here the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR1.136(a)), notify applicant that the omission must be supplied within the time period for reply." [Emphasis Added.]

In responding to applicants' amendment of June 10, 2003 the Examiner has issued a new final action, but is also requiring that applicants correct the omission to the specification. Thus, the Examiner appears to treat the omission both as minor deficiency and a serious omission by both entering the amendment and requiring that applicant supplement the amendment or risk abandonment of the application. Applicants' respectfully submit that the insertion of a "Field of the Invention" and "Description of Related Art" headings into the written description are minor deficiencies as there is no requirement that these headings be included in a written description. In particular, 37 CFR §1.77(b) does not mention either of these sub-headings. MPEP § 608.01(c) states only that the "Background of the Invention section ordinarily comprises" such sub-headings. These subheadings are not at all required and therefore the specification meets the rules set forth under the CFR. In addition, the specification is in line with the MPEP.

In view of the foregoing, applicants respectfully traverse the Examiner's objection and requirement that the

specification be amended to include "Field of the Invention" and "Description of the Related Art" subheadings. Further in this regard, applicants respectfully believe that by now addressing this issue in response to the Official Action of June 23, 2003 that the Examiner's assertion that the amendment of June 10, 2003 was not-fully responsive is now moot. In addition, applicants' amendment of June 10, 2003 should not have been considered non-responsive in the first place because the requested sub-headings are clearly not required.

Turning now to the substantive issues raised by the Final Action. The Examiner has again rejected the claims under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 5,913,210 to *Call* (hereinafter "*Call*").

Regarding claims 1, 12 and 15, the Examiner asserts that *Call* teaches "changing at least one of the characteristic values [col 9, lines 20-35], retrieving the identity of the first entity based on the association with the code associated with the characteristic with the changed value [col. 9, lines 1-19]" and "sending the changed value to the first entity [col. 9, lines 36-56]." Applicants respectfully disagree with the Examiner that *Call* teaches the claimed combination, in particular, those limitations quoted in the previous sentence.

Call discloses a method and apparatus for disseminating product information via the Internet. By *Call*'s method "'a product code translator'" is employed as an Internet resource "for storing cross-references between universal product codes identifying specific products and Internet addresses specifying the locations at which information about these products may be obtained." (*Call*, col. 1, lns. 37-41.) Upon receipt of a user request, the

translator provides the user with the Internet address at which information relating to the product code, in particular, Universal Product Code (UPC), may be found. (*Id.*, col. 2, lns. 48-52; col. 6, lns. 53-62.) In response to a query, a user may also be provided with "all or part of the information from company table 211 to provide information about the manufacturer(s) to whom registered universal product codes are assigned." (*Id.*, col. 7, lns. 31-34.) *Call* also discloses that additional information relating to a product may be stored at a product home page. (*Id.*, col. 8, lns. 42-65.) "This product home page may link to additional information related to the product on other pages where appropriate." (*Id.*, col. 8, lns. 52-53.)

As such, *Call*'s product code translator provides links to various manufacturer or supplier web sites or pages to which users are directed to obtain pertinent information based on a UPC. In particular, the product code translator is described as providing two functions:

"(1) its registration handler 203 accepts cross-references submitted by manufacturers which relate their assigned universal product codes to associated Internet addresses where information relating to their products may be obtained, and (2) its query handler 204 accepts queries via the Internet 205, each query including all or part of one or more universal product codes, and returns the Internet addresses which can be used to obtain information about the products identified by those codes."

[Emphasis Added] (*Id.*, col. 3, lns. 48-58.) Thus, the product translator performs a registration process which allows manufacturers to populate a relational database with product codes that are cross referenced to manufacturers. (*Id.*, col. 3, ln. 61 - col. 6, ln. 31.) In summarizing the registration

process performed by the product code translator, *Call* states, at col. 6, lns. 31-42, the following:

"With the foregoing as background, the registration and query/response functions performed by the product code translator may be summarized as follows: each participating manufacturer, or someone acting on its behalf, submits a registration which generates an incoming registration template 207 containing information about the registering manufacturer, including an identification of the universal product codes which designate products for which information is to be made available, together with the URL which specifies the Internet resource which will make that product information available."

By way of reference to FIG. 2 of *Call* (which FIG. 1 makes clear is the product code translator), the only information stored by the product code translator that relates to a product is the product code, which identifies the product. The remaining information stored by the product code translator is information that identifies manufacturers, such as a URL, email address, address, or company name. *Call's* product code translator clearly does not store any codes that are associated with the characteristic value of a product. In addition, the product code translator is not disclosed as storing or maintaining any characteristics of products. (See *Call's* FIG. 2 and discussion thereof.)

When a user queries the product code translator by inputting a product code, the product code translator responds by providing the user with the location (e.g., IP addresses) for all the manufacturers associated with the product code, to wit:

"When an incoming query is received by the query handler 204, a table lookup function is performed by searching the cross-reference table 215 for a row

record or records which specify a set of universal product codes which include the code or codes specified by the query. If matching row(s) are found, the IP-address(es) found in the matching row(s) are returned to the query submitter, otherwise a special code (such as a zero valued IP address) is returned to indicate that information for the product code(s) of interest has not been registered."

(Id., col. 6, lns. 53-62.) Alternatively, the user may be provided with the email address of the manufacturer in response to a query. (Id., col. 7, lns. 7-30.)

Once the user is provided with the manufacturer's IP address or URL, the user may visit a separate web site or page that is published by the manufacturer. The information published at the manufacturer's web site is located on a product home page and may include product information. (Id. col. 8, lns. 10-65.) A manufacturer may choose to store the information relating to its product and update such a database as the product information changes. (Id. col. 9, lns. 20 - 30.) Thus, when a user ultimately accesses a manufacturer's web site the most up-to-date information is thereby provided to the user.

Thus, in accordance with *Call*, a user accesses the product code translator 101, which provides the user with the IP addresses or URL of manufacturers. The user then uses the URL or IP addresses to access the manufacturer web site and retrieve or access product information.

In contrast, claims 1 and 15 recite "associating the identity of a first entity with at least one of the codes, changing at least one of the characteristic values, retrieving the identity of the first entity based on the association with the code associated with the characteristic with changed

value, and sending the changed value to the first entity." In this regard, claims 1 and 15 are not disclosed or suggested by *Call* because in *Call* the characteristic values of a product are stored at a manufacturer's web site or server and therefore, in accordance with claims 1 and 15, the manufacturer would necessarily have to send the changed value to a first entity, which, based on *Call*, would have to be the product code translator. However, the product code translator of *Call* is not taught as housing characteristic values relating to products. In fact, the only product information retained by *Call*'s product code translator is product codes (see FIG. 2). In addition, *Call* does not suggest placing characteristic value information on the product code translator. Thus, *Call* does not teach sending a characteristic value to the product code translator. It follows therefore that *Call* does not anticipate claims 1 and 15.

Moreover, in accordance with claims 1 and 15, the changed value is sent to the first entity. The only other interpretation of *Call* in view of the claims is that the first entity is the manufacturer, which, in accordance with *Call*, would necessarily result in the manufacturer sending the changed characteristic value to itself. Applicants respectfully submit that this leads to both an illogical interpretation of what's disclosed in *Call* and does not reflect what is claimed.

To be clear, nowhere in *Call* is it disclosed that the identity of a manufacturer or first entity is retrieved based a code associated with a characteristic value of a product, because the entity in *Call* from which identity

information is retrieved, i.e., the product code translator, does not store any product information other than a universal product code (which is not a characteristic value of a product) and the addresses of manufacturers. Thus, the product code translator cannot identify a manufacturer based on information that it clearly does not have access to, i.e., a characteristic value of a product.

As such, *Call* does not anticipate claims 1 and 15.

For the same reasons discussed above, *Call* also does not anticipate claim 6, which recites "modifying the information about the product, identifying a first entity based upon the information code associated with the information about the product, the product data and the destination data, and transmitting the modified information about the product to the first entity."

In addition, because claim 12 recites "means for associating the identity of a first entity with at least one of the codes, means for changing at least one of the characteristic values, means for retrieving the identity of the first vendor based on the association with the code associated with the characteristic with the changed value, and means for sending the changed value to the first vendor," claim 12 is also not anticipated by *Call* for the same reasons.

Turning now to the Examiner's response to applicants' arguments included in the amendment dated June 12, 2003. First off, the Examiner asserts product weight (*Call*, col. 8, line 18) anticipates "storing a first characteristic value associated with the first characteristic" and product volume (*Call*, col. 8, ln. 19) anticipates "storing a second characteristic value associated with the second

characteristic." The Examiner states that "changing at least one of the characteristic values" is anticipated by "[cross-reference between said first universal product code and said first network address]." Thus, the Examiner ignores the plain language of the claim and gives two different inconsistent meanings to the terms "characteristic values" as used in the claims.

The Examiner also asserts that "retrieving the identity of the first entity based on the association with the code associated with the characteristic with the changed value" is anticipated by "first universal product code of the first product." The problem, however, is that the Examiner previously identified the characteristic values as either product weight or volume.

The Examiner then asserts that "sending the changed value to the first entity" is anticipated by "said response being transmitted by said third computer via said network to said fourth computer." The problem with this assertion is that the first entity was identified by the Examiner as the "first manufacturer" and *Call* does not disclose or suggest that a manufacturer sends or transmits a changed characteristic value to any entity. *Call* is clear in disclosing that users access a manufacturer's database or web site based on the IP address or URL retrieved from the product code translator.

The Examiner also points to *Call*, col. 1, lns. 52-65 to support the proposition that *Call* discloses "sending the changed value to the first entity." However, the very text that the Examiner quotes states that the customer can be provided "with detailed information about any listed product

by incorporating links to the product information made available by the participating manufacturer." This supports applicants' arguments.

With respect to col. 6, lns 21-30, applicants respond by saying that in accordance with the claims an IP address is not a characteristic value of a product. In fact, the Examiner admits as much by associating weight and volume with characteristic values.

With respect to the assertion that "transmitting the modified information" is anticipated at col. 6, lns. 53-62. Applicants note that cited text makes no reference to transmitting any information that is modified. The cited text clearly states that if an IP address is not associated with a product code "a special code (such as a zero valued IP Address) is returned." Claim 6 is clear in reciting "providing destination data correlating the information codes to entities," which, with respect to trying to read claim 6 on *Call*, would be the IP address and "modifying the information about the product," which would then not be the IP address.

Based on the foregoing, applicants' respectfully submit that *Call* fails in many respects to anticipate claims 1, 6, 12 and 15. In addition, the Examiner's arguments supporting the rejection of the claims is logically inconsistent as the Examiner associates many different meanings with a given limitation recited in the claims, e.g., the characteristic values. As the remaining claims either directly or indirectly depend from either of claims 1, 6, 12 and 15, applicants also respectfully submit that these claims are not anticipated by *Call*.

As such, applicants earnestly request reconsideration and allowance of the claims pending in the application, namely claims 1-9 and 12-18. In this regard, as applicants are filing a response to the Final Office Action within two-months of its mailing date, applicants look forward to receiving an advisory action from the Examiner.

If for any reason the Examiner does not believe that the Amendment of June 10, 2003 can be entered at this time, it is respectfully requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested supplemental amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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